

DOCKET NO. 2002.01.037.WTO
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PATENT

REMARKS

Claims 1-20 were originally filed in the present application.

Claims 1-4, 6-8, 10-15, 17-19 and 21-26 are pending in the present application.

Claims 1-4, 6-8, 10, 12-15, 17-19, 21, 23 and 25 were rejected in the June 19, 2006 Office Action.

Claims 11, 22, 24 and 26 were objected to in the June 19, 2006 Office Action.

Reconsideration of the claims is respectfully requested.

PREMATURE FINAL REJECTION

The Examiner makes this Office Action final, and states that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action." Applicant respectfully assumes that this finality is made in error, and expects that it will be withdrawn.

The previous response to an Office Action, filed January 25, 2006, made no amendments to the claims, and so could not have necessitated the new rejection over new art. A response filed on September 20, 2005 did amend the claims, and in response, the Examiner mailed a final Office Action (including new grounds of rejection) on December 1, 2005, indicating at that time that the September 20, 2005 amendments necessitated those new grounds of rejection.

As the most recent amendments to the claims were fully examined and subject to a final rejection over new art last year, those amendments could not have "necessitated" the new grounds of

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rejection in the current Office Action. Since there have been no claim amendments since that time, the present Office Action is prematurely final in light of the new art rejections.

If the Examiner intends to maintain both the finality of the Office Action and the current rejections (traversed below), he is respectfully requested issue an Advisory Action as quickly as possible so that a petition regarding the premature finality can be filed with or before the Notice of Appeal. Alternately, an interview with the Examiner and the Technology Center Director may serve to resolve this issue informally.

ALLOWABLE SUBJECT MATTER

The Examiner objected to Claims 11, 22, 24 and 26 as being dependent upon a rejected base claim, but indicated that Claims 11, 22, 24 and 26 would be allowable if it were rewritten in independent form including all the limitations of the base and intervening claims. Applicant thanks the Examiner for this suggestion but elects not to rewrite Claims 11, 22, 24 and 26 at this time.

CLAIM REJECTION UNDER 35 U.S.C. § 103

Claims 1-4, 6-8, 10, 12-15, 17-19 and 21, 23, and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent Application Publication No. 2002/0142792 to Martinez (hereafter, "Martinez"), and in view of United States Patent No. 6,907,254 to Westfield (hereafter, "Westfield") and further in view of United States Patent Application Publication No.

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2003/0051041 to Kalavade *et al.* (hereafter, "Kalavade"). The Applicants respectfully traverse the rejection.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-133 (8th ed. rev. 4, October 2005). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.* To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

The Applicants direct the Examiner's attention to independent Claim 1, which contains the unique and novel limitations emphasized below:

1. For use in a wireless communications system, a system
for automatically customizing operation of a wireless device
comprising:

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a small area transmitter supporting wireless connectivity with wireless devices and a behavior service defining behavior of wireless devices within a service area for the small area transmitter,

wherein a wireless device,

upon detecting the behavior service upon entering the service area and receiving a behavior set from the small area transmitter, automatically sets operation of the wireless device to conform to the behavior set and associated user preferences, and

upon detecting unavailability of the behavior service following previous availability of the behavior service, automatically restores operation of the wireless device to a state existing prior to automatic setting of the operation of the wireless device to conform to the behavior set and associated user preferences. (Emphasis added)

The Applicants respectfully submit that the above-emphasized limitations of Claim 1 are not disclosed, suggested, or even hinted at in Martinez, Westfield, Kalavade, or any combination of them. Arguments with regard to Martinez and Westfield as presented in the previous response are repeated below. The Examiner made a new rejection to include Kalvade, and expressly concedes that the combination of Martinez and Westfield does not teach or suggest a behavior set, as claimed.

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Martinez discloses cellular telephones that allow a user to define operational settings (such as ring on/off, vibrate on/off, ring loud/soft) and store the settings as user preference information. See Martinez, paragraph 0004. Such sets of user preference information are stored in the cellular telephone. See Martinez, Fig. 7, paragraph 0037. Utilizing the method and apparatus of the Martinez reference, as specified conditions or triggers are sensed, a corresponding set of user preferences is selected. See Martinez, Fig. 1, paragraph 0021.

For example, the movement of a cellular telephone into a private telephone network causes the telephone to select a first specified set of user preference information. See Martinez, paragraph 0022. That is, entry of the telephone into a private network causes the selection of user preferences entered by the user, rather than preferences received from the private telephone network. As a result, the Martinez reference does not teach a wireless device which, upon detecting a behavior service upon entering the service area of a small area transmitter and receiving a behavior set from the small area transmitter, automatically conforms its operation to the received behavior set, as recited in independent Claim 1.

Furthermore, the subsequent movement of the telephone into a public telephone network causes the telephone to select a second specified set of user preference information. See Martinez, paragraph 0023. That is, the selection of user preferences is performed in response to entering the public network, rather than exiting the private network. Moreover, upon entering the public network, the telephone selects user preferences associated with the public network, rather than restoring preferences in use before the telephone entered the private network. As such, the Martinez

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reference does not disclose a wireless device which, upon detecting the unavailability of a previously available behavior service, automatically restores its operation to a state that existed prior to its entry into the service area of the small area transmitter, as recited in independent Claim 1.

Westfield is drawn to systems and method for spatially controlling cellular phone usage. The Examiner states that Westfield teaches "a small area transmitter (see figure 1B, base station 21 is included a transmitter) supporting wireless connectivity with wireless devices (see figure 3A, IP phone 330) and a behavior service defining behavior of wireless devices within a service area for the small area transmitter (see figure 3A, col. 6, ln. 3-42), and the mobile phone receiving an IP message from the small area transmitter (see col. 2, ln. 29-40)", as required by claim 1.

Westfield describes a method of enforcing a quiet zone by putting phones in the quiet zone into a quiet mode. When a phone enters the "quiet zone", a central facility receives an IP message that identifies the phone. The central facility preferably is a switching center. The central facility sends a hushing command to the phone, preferably by sending an IP message to the base station, which relays it to the phone. The hushing command causes the phone to go into a quiet mode and can be configurable, for example it can be a command for the phone to turn itself off.

As described in this passage of Westfield, the wireless does not receive a behavior set from a small area transmitter, rather, it receives an "IP message" from a "central facility", which is a base station (col. 6, line 38), as the Examiner concedes. As described in the specification as filed, the claimed "small area transmitter" can be, e.g., a Bluetooth or similar transmitter. Such transmitters have very limited transmission distances, hence "small area". No reasonable interpretation of the

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current claims could include a mobile switching center or base station of a cellular wireless communication system as described in Westfield.

In the final Office Action mailed February 8, 2006, the Examiner dismisses this distinction with the statement that “the features upon which applicant relies (i.e., Bluetooth) are not recited in the rejected claim(s).” The Examiner apparently misses the point. The claims require a small area transmitter. A cellular base station is not a small area transmitter. Westfield teaches “Each of the base stations 21 covers a geographic area as A4 [*sic*, this term does not actually appear in the Westfield application] known in the art of cellular communications” (col. 2, lines 10-12). It certainly is well known in the art of cellular communications that a base station covers a geographic area – an area typically ranging from a square block to several square miles, depending on terrain. This is not a “small area” as used in the present application. The Bluetooth transmitter referenced in the specification gives an example of a small area transmitter, and illustrates the difference between the claimed small area transmitter and a wide-area transmitter such as a cellular base station.

Further, claim 1 requires that the small area transmitter supports a behavior service defining behavior of wireless devices within a service area for the small area transmitter. The Examiner has conceded that Martinez fails to teach a small area transmitter supporting a behavior service defining behavior of devices with a service area for the small area transmitter. Westfield similarly fails to teach this feature.

This “IP message” is alternately described as “causing [the phone] to change behavior” (col.2, line 36), “an IP message that can include a hushing command” (col. 2, line 52), “an IP

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message is sent to the cellular phone device that includes notification that the cellular phone devices has entered a quiet zone" (col. 3, lines 6-9). None of these descriptions teaches or suggests at all that the "IP message" is a "behavior set" as claimed.

Westfield does not teach or suggest that the base station supports a behavior service defining behavior of wireless devices within its service area, as claimed. The base station does forward an IP message, but Westfield expressly teaches that "the IP message is one that has been sent by a quiet zone controller and has been relayed through the radio access network to the central facility" (col. 6, lines 32-36). Westfield alternately teaches that the "central facility" can update "the status of the phone" (col. 7, lines 13-16). In either case, the base stations, which the Examiner alleges correspond to the claimed small area transmitter, do not support a behavior service defining behavior of wireless devices within its service area, as claimed.

As such, Westfield does not teach or suggest "a wireless device, upon detecting the behavior service upon entering the service area and receiving a behavior set from the small area transmitter", where the "small area transmitter support[s] wireless connectivity with wireless devices and a behavior service defining behavior of wireless devices within a service area for the small area transmitter," as required by claim 1, as Westfield does not include a small area transmitter and Westfield's base station cannot meet the claimed requirements corresponding to the small area transmitter.

The Examiner concedes that neither Westfield or Martinez, nor any combination of them, teaches or suggests a behavior set, as claimed. The Examiner makes a new rejection to include

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Kalavade, stating "Kalavade teaches a behavior set (read on the IP messages which is included an attribute value pairs, [0063])." Kalavade's paragraph 0063 teaches in its entirety:

Authentication and billing in LANs is typically done through IP mechanisms such as RADIUS and DIAMETER. RADIUS is an IETF specification and specifies a mechanism for authenticating a remote user into the network through an attribute/value pair such as a login name and a password. RADIUS also allows collection of accounting information, where the network access server sends accounting information to a RADIUS server. The access server typically sends duration, number of packets, and other usage information to the RADIUS server. The billing system then generates a bill based on the appropriate fee policy.

As can be seen, Kalavade teaches an "attribute/value pair" that is used for authenticating a user, and can be a login name and password. Kalavade does not teach anything else it its entire disclosure about an "attribute/value pair". This clearly has nothing to do with a behavior set, as claimed. In fact, Kalavade's billing/authentication system has nothing at all to do with the claimed invention.

As is clear, then, no art of record includes any teaching of a behavior set, as claimed in claim 1 and the other independent claims.

While claim 1 has been discussed in detail above, claims 3, 7, 12, 14 and 18 include similar distinguishing limitations. Thus, independent Claims 1, 3, 7, 12, 14 and 18 contain unique and non-obvious limitations that are not disclosed, suggested, or even hinted at in Martinez, Westfield, Kalavade, or in any combination of these references. This being the case, Claims 1, 3, 7, 12, 14 and 18 are patentable over the all art of record.

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Also, dependent Claims 2, 4, 6, 8, 10, 11, 13, 15, 17, 19 and 21-26 depend from independent Claims 1, 3, 7, 12, 14 and 18, directly or indirectly, and contain all of the unique and non-obvious limitations recited in the base claims. As such, all dependent claims also are patentable over all art of record. Thus, the Applicants respectfully request the withdrawal of the §103 rejection of Claims 1-4, 6-8, 10, 12-15, 17-19 and 21, 23, and 25.

Finally, there is no proper motivation to combine the references as alleged by the Examiner. The Examiner's only stated motivation to combine is "to prevent RF interference to sensitive devices as suggested by Westfield". Westfield does teach that turning off a phone in a "quiet zone" could reduce RF interference. However, nothing in Martinez or Kalavade teaches or suggests that it would turning off the phones would be desirable at all – in fact turning off the phone to prevent RF interference would defeat the purposes of Martinez and Kalavade and render those systems inoperable.

All rejections are traversed.

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SUMMARY

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckbutrus.com*.

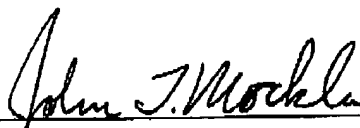
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

Date: 21 Aug. 2006

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